

REMARKS

Claims 1-18 were previously pending. Claims 12-14 have been canceled. Claims 1 and 18 have been amended in an effort to better define the claimed invention. New claim 19 is intended to further distinguish from the prior art. Support for the amendments to claims 1 and 18 may be found at paragraphs [0012], and [0019]. Support for new claim 19 may be found at paragraphs [0007] and [0015]. Upon entry of the present amendment, claims 1-11 and 15-19 are pending in the application.

Amendments to, cancellation of, and additions to the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the following remarks.

As a preliminary matter, Applicants note that several different inventions were previously present in the pending claims. For example, claims 1-11 and 18 are directed to an aqueous pigment paste. In contrast, claims 12-14 disclosed an aqueous coating material comprising the aqueous pigment paste of claim 1. Claims 15-17 encompass a process for making an aqueous coating material by using the pigment paste of claim 1. Claims 12-14 have now been canceled in order to focus on the pigment paste compared to the aqueous coating material. Thus Applicants, therefore, have two separate and distinct inventions, a pigment paste and a process of making a coating material with the pigment paste.

1. **Provisional rejection of claims 1-18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/522,835 (published as US PGPub 2006/0155022).**

Applicants herewith submit a terminal disclaimer with respect to copending Application No. 10/522,835.

Applicants also hereby affirm that the present Application No. 10/512,035 and the invention of copending Application No. 10/522,835 were, at the time the invention of the present Application was made, owned by BASF Coatings AG.

2. **Rejection of claims 1-18 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.**

Claims 1-18 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the reason that the property of showing “no settling after six months” for the claimed composition does not appear to be a written description with respect to the generically claimed composition in the application as originally filed, as compared to the specific exemplified compositions of Example 1 and Example 2 on the last page of the specification.

Applicants respectfully traverse this rejection. The originally filed application stated, in paragraphs [0007] and [0015], that the aqueous pigment paste is storable for more than one year without settling and without the formation of inhomogeneities or coagulum. The lesser period of “even after six months” represents one selected reasonable test of that storability property, based on a reasonable interpretation of the application as a whole.

3. **Rejection of claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,284,037 to Sapper, hereafter “Sapper”, in view of CA 2,154,818 to Bergfried et al., hereafter “Bergfried.”**

The Office Action states that Sapper discloses an additive for a coating formulation, used for basecoats, comprising a nonassociative rheology stabilizer such as the exemplified Viscalex HV30 nonassociative thickener, mica pigment, water, and

polypropylene glycol as a nonionic surfactant, mixed with a polyurethane binder (col. 4, lines 25-65). The Office Action further states that Sapper teaches the use of a tertiary amine such as dimethylethanolamine to control pH. The Office Action states that the amounts of mica, nonassociative thickener, and nonionic surfactant in the exemplified coating composition overlap with the claimed amounts in the coating composition of claim 15. 01/05/2009 Office Action page 3, section 4.

The Office Action concedes that Sapper does not disclose (i) preparing a pigment paste without binder comprising mica pigment, nonassociative rheology stabilizer, nonionic surfactant, and amine compound and (ii) an amount of 15-25% mica pigment. 01/05/2009 Office Action page 3, section 4.

The Office Action states, however, that the secondary reference to Bergfried discloses a pigment concentrate comprising a pigment, a polyacrylate-based thickener, a nonionic surfactant, an amine, and water, wherein the pigment paste is added to a binder resin to effect appropriate mixing. 01/05/2009 Office Action page 4, para. 1.

The Office Action alleges that, given the teachings of Sapper and Bergfried, "it would have been obvious to one of ordinary skill in the part to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition" and thereby have a pigment paste that intrinsically shows no settling after six months. 01/05/2009 Office Action page 4, para. 3.

Applicants appreciate the detailed basis for rejection but must respectfully disagree. Applicants respectfully submit that the present claims are patentable over the combination of Sapper and Bergfried for the following reasons.

Sapper is not directed to a paste, certainly not a paste of a mica pigment, but rather the addition of a polymer dispersant additive to a coating material that, in the examples, contains either 0 or about 3 wt.% mica pigment. Thus, Sapper does not remotely teach or suggest a pigment paste that solves the problem of long-term stability.

Applicants note that the whole purpose of Sapper is to avoid the formation of an unstable paint. In column 4, Sapper provides two examples of paints, one containing 0.2 percent aluminum pigment and 0 percent mica pigment, and one containing 4 percent blue pigment and 3 percent mica pigment, which paints have an initial viscosity of 86 and 81 mPa · sec, respectively. Comparing such viscosities to known materials, it can be easily determined that these paints are not pastes. For example, the viscosities of castrol oil, honey, and ketchup are, respectively, 1000, 10000, and 50000 mPa · sec. Thus, while more viscous than water, the compositions of Sapper do not remotely resemble a paste such as is claimed by Applicants. Furthermore, "paints" and "coating materials" in general are not referred to as pastes for good reason, that being that they are not pastes by common usage of the word. Applicants are not using the presently claimed mica pigment paste as a paint or coating material but as a storage stable intermediate for use in making a coating material.

Beyond that, however, it is important to understand that there is no evidence that Sapper used a pigment paste to make his coating composition. There is no mention of a pigment paste anywhere in Sapper. What Sapper does teach is an additive for a coating formulation. Abstract. The additive comprises a small amount of (i) a specified acrylate polymer and (ii) a nonassociative stabilizer. The nonassociative stabilizer can be Viscalex HV 30, as noted by the Examiner. However, neither the additive nor the coating formulation is a mica paste.

The purpose of Sapper's additive is to improve the stability of a coating formulation. Col. 1, lines 30-34. In particular, Sapper states:

The polymer dispersions used in accordance with the invention are outstandingly suitable as viscosity adjusters and as a stabilizer for coating formulations, especially for aqueous coating formulations, in order to improve the rheological stability of these coating formulations....The polymer dispersion used in accordance with the invention has been found particularly suitable as an addition to coating materials, such as metallic paints, for automotive finishing. [Emphasis added.]

Col. 1, line 53, to col. 2, line 6.

Thus, the nonassociative thickener of Sapper is not used as a thickener for a mica paste, nor for any pigment paste, but for a paint. A paste is not a paint. One cannot and would not coat a substrate with a pigment paste. One does not coat using a paste, nor with a composition containing 21.1% of mica pigment, as in the Example of a mica pigment paste on page 11, Table 1, of the present specification. Rather, the paste is greatly diluted in the final coating composition, as indicated in present claim 15, in which 2-6% of the mica pigment is contained in the aqueous coating material.

Sapper further states, "The polymer dispersions can be added to any desired known aqueous coating formulations, such as aqueous formulations based on polyurethane, on polyester, on acrylate or on epoxy, and to aqueous 2-component coating systems based on isocyanate." Col. 3, lines 33-37. So Sapper actually teaches that the nonassociative stabilizer is, in fact, not part of any paste and is, in fact, added to a formulation comprising a binder, which is clearly contrary to the presently claimed invention.

The fact that Sapper teaches nothing about a mica paste, or any pigment paste for that matter, is further illustrated by the Examples in Sapper. Sapper, in fact, adds the Viscalex HV30 to a stored paint, not to a pigment paste. Col. 4, line 61. Furthermore, claim 1 of Sapper claims a method of stabilizing an aqueous coating formulation which in claim 2 is described as selected from the group consisting of one-component waterborne coating formulations, two-component waterborne coating formulations, and physically drying waterborne coating formulations.

Thus, Applicants respectfully submit that Sapper, as a whole, does not teach or suggest what the Examiner is alleging, i.e., Applicants' pigment paste. Sapper teaches an example (Paint 2 in col. 4) that includes a mica pigment among a myriad of components, four of which are binders. Sapper does not teach, suggest, motivate, or even allude to an aqueous mica paste, let alone one that is free from binders and grinding resins such as the one in Applicants' independent claim 1. As a whole, or in part, Sapper does not provide any basis for arriving at Applicants' independent claim 1. Rather, Sapper specifically teaches away from adding a nonassociative thickener to any pigment paste, let alone a

mica paste. Moreover, Sapper teaches away from even adding the nonassociative thickener to any composition that does not have a binder and that is not a paint, in contrast to the present invention, which is directed to a mica paste that cannot be used as a coating, but only as a component for preparing a coating, in which a specific nonassociative thickener is used without a binder.

The Office Action states, in Response to Arguments, that Applicant argues (A) that Sapper does not teach a pigment paste. The Office Action responds by stating:

With respect to (A), given that Sapper discloses a composition comprising mica...and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition because changing the mixing order is *prima facie* obvious since the end-product is the same....

(01/05/2009 Office Action page 5, para. 2.)

Applicants respectfully submit that it makes little sense to state that "mixing order" for a final paint composition is *prima facie* obvious, when the invention relates to a pigment paste, which pigment paste is storable for a year or more, and when the purpose of the invention relates to that improved storability. A final paint composition does not render *prima facie* obvious any combination of its ingredients (and concentrations thereof) in a independent and separate composition, particularly when about 20 different ingredients are involved, as in Table 1, col. 18, of Sapper. Finally, as discussed above, Sapper actually teaches a mixing order that is plainly contrary to the claimed composition of the present pigment paste.

In this regard, it is held that "[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). For at least this reason, Applicants further respectfully assert that Sapper cannot be used as a prior art reference because it teaches away from the present independent claims 1 and 18. These deficiencies are not, and cannot be, remedied by Bergfried.

Thus, turning now to Bergfried, the Office Action seems to imply that Bergfried teaches a mica-like pigment paste. The Examiner equates Bergfried's electrically conductive pigment based on metal oxides to Applicants' mica pigment. Applicants respectfully submit, however, that this alleged equivalency is improper, because it is generally known in the art that when it comes to aqueous solution behavior and stability, an ultrafine electrically conductive pigment based on metal oxides is substantially different from mica pigment. The courts have held that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art...." *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

Thus, Bergfried is indeed directed to a pigment paste, but not a mica pigment paste. A mica pigment paste is made up of particles that have a special layered construction and, rather than being conductive, are known to have a high dielectric strength, making it a favored material for an insulator. In contrast, the material of Bergfried relates to "an aqueous concentrate of an electrically conductive, ultrafine pigment" that can be used in an antistatic coating. Page 1, lines 1-2. Bergfried teaches a pigment paste composed of "electrically conductive pigment, tin (IV) oxide, doped with antimony and/or fluoride, which optionally is coated onto a supporting pigment (rutile, barium sulfate, mica, etc.)." Page 3, lines 28-31.

The Examiner has previously taken the position that "given that the density of a metal oxide pigment is approximately that of mica...a pigment paste composition sufficient to keep dispersed a metal oxide as taught by Bergfried (e.g., tin oxide, about 6 g/cc) would be suitable for mica (about 5 g/cc)". (4/11/2008 Office Action, page 4, third full paragraph).

Applicants respectfully submit that the Examiner has yet to adequately support, on any factual or technical basis, the equivalence of Bergfried's conductive ultrafine conductive metal oxide pigment to the present mica pigment. It is well known that the density of a compound and/or particle is not very critical to its ability to disperse in a medium. Many other aspects of a compound and/or particle are more relevant. For example, properties such as surface polarity, particle size, particle shape, surface charge,

geometry, swellability, etc., are likely to be more critical than density in determining dispersability. In addition, Applicants respectfully submit that the Examiner has not provided any basis why a change of from 5 to 6 g/cc, i.e., a 20% increase in density would not also significantly or unpredictably change the behavior of a pigment in a paste.

Therefore, even if the combination of Sapper and Bergfried was proper, which it is not, since, as discussed above, Sapper teaches away from independent claims 1 and 18, one of ordinary skill in the art would not be motivated to arrive at Applicants' claim 1 or claim 18. At the least, this is because Bergfried's electrically conductive pigment based on metal oxides is substantially different from Applicants' mica pigment in terms of aqueous solution behavior, including stability and the like.

The purpose of the present invention is to provide a novel aqueous pigment paste comprising mica particles, which can be prepared simply, transportably, storably, and stably, without damage to the mica particles. In contrast, Sapper is directed to a particular additive composition that is used to provide improved stability of aqueous coating compositions such as metallic paints for automobiles. Abstract and col. 12, lines 3-6. As illustrated in Sapper's working examples, only very low amounts of mica or other pigments are used in the aqueous paint or coating compositions. For example, Sapper uses no mica pigment in Paint 1 and 3 wt.% mica pigment in Paint 2 in conjunction with color imparting pigments such as carbon black and blue pigment. Thus, Sapper is absolutely silent as to pigment paste technology, the problems attendant to such pastes, or any solutions thereto. That is, Sapper's teachings relate to finished coating compositions that can be stored and applied without further modification.

The Office Action states, in Response to Arguments, that Applicants argue (B) that neither Sapper nor Bergfried teaches a pigment paste showing no settling after six months. The Office Action responds by stating:

With respect to (B), while Sapper and Bergfried do not teach the specific timeline of six months with respect to no settling, Sapper and Bergfried both teach improved stabilization by using the presently claimed non-associative thickener with solid pigments. Therefore...it would have naturally flowed from their

teachings that the composition not show settling after six months. (01/05/2009 Office Action page 5, para. 3.)

Applicants respectfully submit that, although “stability” can be a factor in both a pigment paste and a finished coating composition, the stability issue is measured/defined differently in each and has different concerns. For example, Sapper refers to viscosity changes after 80 days and to processing properties. In contrast, settling and watery phase formation after six months, and ideally one year, are the focus for the stability of Applicants’ pigment pastes. The stability of Bergfried’s pigment pastes also is measured differently from traditional pigment pastes, since Bergfried’s pastes are a special subset of electrically conductive pigments that must carry a charge in the final application. As such, their “stability” is measured in a 1 to 20 dilution in deionized water. (Page 6, lines 26-28.) Thus, those of ordinary skill in the art would appreciate that “stability” is a term that must be considered in the context of the particular composition in question.

Those of ordinary skill in the art would also understand that while shelf life and stability are necessary concerns in paint and coating compositions, such problems as settling and reduced shelf life are greatly exacerbated with regard to pigment pastes. While coating and pigment pastes may share certain raw material components, they are not equivalent or even similar in terms of either composition or performance. In fact, the performance of a pigment paste refers to the stability of the pigment paste while stored and its ability to impart as much color or effect to a complete paint or coating in as small an amount as possible. In contrast, the performance of an automotive paint or coating composition generally refers to the appearance and protective characteristics of the finished film that results after application and cure of the paint or coating in question.

Indeed, the purpose of a pigment paste is to facilitate the storekeeping of pigments and make it as easy as possible to use the pigment paste in the manufacture of a finished or complete paint or coating composition. Those of ordinary skill in the art would appreciate that pigments in their raw state can pose safety, health, stability, and/or use issues. However, the desire to obtain pigment pastes with a maximum concentration of pigment must often be balanced by stability concerns. A pigment paste with poor

stability produces a paint or coating with poor quality, as discussed in the present specification in paragraph [0005].

Related to the stability issue, the present invention is also unobvious over Sapper and Bergfried because the combination does not suggest Applicants' specified range of the mica pigment in the paste, namely, 15-25% wt.% mica pigment. The Office Action states:

[When] Paint 2 is combined with 0.098 wt.% Viscalex HV 30 in the examples of Sapper, the relative amount of mica to thickener is 30.6:1. The presently claimed amount provides for a ratio of mica to thickener of 20:1 to 125:1. Therefore, the relative amount of mica in the paint to thickener is encompassed by the presently claimed relative amounts of mica to thickener in the pigment paste. Therefore, one of ordinary skill in the art would utilize an appropriate (and relatively higher) amount of mica relative to thickener in order to prepare a pigment paste as taught by Bergfried to be added to the coating formulation of Sapper.

(01/05/2009 Office Action page 4, para. 3.)

Applicants respectfully submit that the 15-25% wt.% mica pigment required by the present invention does not logically follow from the relative amount of thickener to mica in the final paint composition of Sapper. As noted above, the goals of a mica pigment paste are fundamentally different from the goal of using a mica pigment in a final coating.

The Office Action also states, in Response to Arguments, as follows:

With respect to argument (C), Sapper discloses 3 wt % mica when present in a coating formulation. The motivation to have the presently claimed higher concentration of mica is provided by Bergfried which teaches pigment concentrates which are diluted to provide coating formulations like Sapper with necessarily lower concentrations of mica....Therefore, it is evident that Sapper does not disclose concentrations of mica in a coating formulation that are too low.

(01/05/2009 Office Action pages 5, last para, to page 6, first para.)

Thus, with respect to the amount of mica pigment, while Sapper discloses an amount of mica pigment in a coating composition that is much less than presently claimed, Bergfried discloses an amount of other pigment that is substantially more than

presently claimed. It does not logically follow that the prior art teaches a relatively narrow middle range, merely because it is between that of a final paint and a much more concentrated pigment paste of a different material.

Nor does Bergfried provide any motivation with regard to the concentration limitations for the mica pigment in Applicants' claims 1 and 18. Mica pigment has fundamentally different chemistry and dispersion issues as compared to electrically conductive fluorine doped tin oxides used in Bergfried. The Office Action has failed to provide any common sense rationale as to how this technical gap can be bridged by any motivation for one of ordinary skill in the art to do what Applicants have done.

Moreover, Applicants are not arguing merely that the amount of mica pigment in the paste is novel, but rather that the stability obtained for the novel composition, including the amounts of critical components, is unobvious and unexpected, which is further evident by comparing the demonstrated stabilities for the present compositions to that of only ten hours achieved by Bergfried for a paste comprising tin oxide.

Applicants respectfully maintain that the amount of from 15 to 25% by weight of mica pigment, as recited in independent claims 1 and 18, is indeed unobvious. There is no teaching or suggestion in the cited prior art to use 15-25% by weight of at least one metal pigment, let alone 18-23%, as required by claim 2.

Applicants respectfully submit that to find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Applicants respectfully submit that no such reason has been identified by the Examiner as to why one with ordinary skill in the art would change Bergfried's 40 to 60% to Applicants' 15 to 25% by weight. The only reason given by the Examiner appears to be that the claimed amount is not relevant because it is less than the amount taught by Bergfried and more than the amount taught by Sapper. However, the Office Action has not reasonably explained how one of ordinary skill in the art would arrive at Applicants' particular concentration of mica. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must

be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

Finally, Bergfried cannot be used to correct the deficiencies of Sapper and cannot teach the present invention for still another important reason. Bergfried, like Sapper, fails to teach the requirement of the present invention (as recited in claims 1 and 18) that "the aqueous pigment paste is free from binders, including grinding resins used for dispersing pigments." The present specification states:

The pigment paste of the invention...was substantially free from organic solvents, binders, and grinding resins. Additionally, only comparatively small amounts of additives were needed. Despite this, the pigment paste of the invention was surprisingly stable, transportable, and storable....(page 6, lines 1-7.)

In this regard, the Comparative Example on page 11 of the present Application shows that, while pigment pastes according to the invention showed no settling even after six months, a comparative pigment paste that contained binder underwent coagulation after just one week and was no longer suitable for preparation of aqueous basecoat materials. This was unpredictable based on the prior art.

Applicants submit that Bergfried teaches the use of a binder in a conductive metal oxide paste, contrary to the present invention. As indicated in claim 1 of Bergfried, the composition of Bergfried includes, not only a polyacrylate thickener in the amount of 0 to 2.0%, but also 2 to 4.9% of a terpolymeric, anionic polyacrylate, which satisfies the definition of a binder. (It is noted that the present invention requires the thickener, an additive, to be used in an amount less than 1%).

A binder is the film-forming component of a composition in the paint industry. In addition to pigment, binder, and solvent, a composition in the art or field of paints can have a wide variety of miscellaneous additives, which are usually used in very small amounts and yet can provide a significant effect on the product. Bergfried's terpolymer is not an additive. In Examples 2, 4, and 5 of Bergfried, the terpolymer is used in an amount of 4 to 5 wt%. This is in contrast to a Comparative Example 1, in which it was used at 2.5 wt%, which was apparently insufficient. It is respectfully submitted that a

polymer used in an amount of 5% cannot be viewed as an additive, as compared to a binder, in the art of paints.

Thus, Bergfried teaches away from the present invention, to the extent it might be relevant to mica pigments, by specifically stating that a certain terpolymer binder material is required for stability. This terpolymer is used as a binder material in addition to (and in substantially different amounts from) a nonassociative thickener, in contradistinction to the present composition. In fact, based on the experimental results shown in the table on page 8 of Bergfried, a very specific type of terpolymer binder (binder type 1 or 3) is required, compared to the binder type 2. Finally, unless this binder is used, the compositions are unstable after only 1 hour, whereas with the binder required by Bergfried and excluded by the present invention, the stability is shown to be achieved for merely 10 hours, as compared to the considerably greater storability of the present mica pigment paste by avoiding the presence of binder.

Moreover, not only is the terpolymer of Bergfried a binder, broadly speaking, but it is also a grinding resin, also excluded by the present claims. As pointed out in Applicants' previous amendments, the term "grinding resin" is not a process limitation, but rather a compositional limitation. Therefore, the composition does not require grinding, although a pigment paste might normally require grinding. One of ordinary skill in the art would know that grinding pigments can be used for dispersing pigments irrespective of grinding, but it can also be used for a dispersing effect in combination with grinding. This is clearly stated by amended claims 1 and 18, which recite that the grinding resin is "used for dispersing pigments." It is further noted that Bergfried uses milling or its equivalent to divide pigment agglomerates (page 4, lines 13-22).

Furthermore, Applicants specification discloses, for example, that "grinding resins are used for dispersing pigments," and that "they are binders whose capacity for dispersing pigments is particularly high." (Page 5, para. 0019.) Therefore, it is respectfully asserted that a grinding resin is a resin or binder that can be used for stabilizing a pigment dispersion. This is further affirmed by the prior art relied upon by Applicants in a previous amendment, i.e., United States Patents Nos. 6,476,170 and

6,630,211 to Roth and Baumgart, respectively. Roth, for example, discloses that "[i]n use, the [grinding] resins are suspended in water to form a solution and made into a dispersion, known as a latex, by neutralizing them with a base [...]" (Roth, column 1, lines 24-27). Nowhere does Roth require any "grinding." Like Roth, Baumgart does not require any "grinding." Applicants respectfully assert that Bergfried's grinding resin is equivalent to that of Roth and Baumgart in terms of its use as a stabilizer.

Applicants respectfully submit that irrespective of whether the terpolymer of Bergfried is a grinding pigment or a binder, or both, the terpolymer of Bergfried is both essential to Bergfried's metal oxide paste and specifically excluded by the present claims. Therefore, Bergfried does not remotely teach or suggest the invention of Applicants' independent claims 1 or 18, reciting a mica pigment paste free from binders and grinding resins. For at least this reason, Bergfried (like Sapper), in fact, teaches away from the claimed invention.

Finally, although the combined teachings of Sapper and Bergfried are silent about whether a pigment paste is stable, transportable, and storable for up to six months or even a year, as set forth by Applicants' claims 1, 18, and 19, the Office Action states, "it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition and thereby have a pigment paste that intrinsically shows no settling after six months." 01/05/2009 Office Action page 4, para. 2.

Significantly, however, there is no evidence that the ultrafine conductive metal oxide paste of Bergfried comprising the specified terpolymer stabilizer is stable for a period greater than about 10 hours. In fact, small variations (as shown by Comparative Examples 1 and 6 in Bergfried) were found to result in the composition becoming unstable in less than one hour. Yet the difference between Examples 2, 4, and 5 of Bergfried from the unstable Comparative Examples 1, 3, and 6 of Bergfried is less than the difference between Examples 2, 4, and 5 of Bergfried and the composition of the present invention. In further contrast, a mica pigment paste of the present invention can

be storable for up to one year without settling and without the formation of inhomogeneities or coagulum (page 4, para. 0015, for example).

In view of the above, Applicants respectfully assert that the present claims are patentable over the prior art, because the combination of the cited art does not teach or suggest all the elements of the present claims and does not provide any teaching or motivation to modify the prior art to arrive at Applicants' claimed invention. In addition, Sapper and Bergfried, alone or in combination, teach away from Applicants' claimed invention, and as such cannot be used to support obviousness. Withdrawal of this rejection and allowance of the claims are respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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